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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Kirkley  
Serial No.: 10/668,395  
Filed: September 23, 2003  
For: PERSONALIZED SECURITY METHOD FOR A SELF-SERVICE  
CHECKOUT SYSTEM  
Group: 3687  
Examiner: An, Ig Tai

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Durham, North Carolina  
April 13, 2010

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Response to Notification of Non-Compliant Appeal Brief

Sir:

In response to the Notification of Non-Compliant Appeal Brief mailed February 24,  
2010, attached are revised sections of the Appeal Brief.

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A. Rejection under 35 U.S.C. § 103(a) over Swartz in view of Walter

This rejection is not supported by the relied upon art. 35 U.S.C. § 103 which governs obviousness indicates that "differences between the subject matter sought to be patented and the prior art" are to be assessed based upon "the subject matter as a whole". Analyzing the entirety of each claim, the rejections under 35 U.S.C. § 103 are not supported by the relied upon art as addressed further below. Only after an analysis of the individual references has been made can it then be considered whether it is appropriate to combine teachings. However, as addressed further below, an objective analysis considers failure of others, the lack of recognition of the problem, and must avoid the improper hindsight reconstruction of the present invention. Such an analysis can appropriately consider whether any modifications are actually suggested by the references rather than assuming they are obvious. The 35 U.S.C. § 103 rejections made here pick and choose elements from either two or three separate references.

Claims 1, 2 and 4-15

These claims were rejected based on Swartz in view of Walter. As addressed in greater detail below, the rejection of these claims is not supported by these items.

Swartz is entitled "Statistical Sampling Circuitry Methodology for Self-Scanning Checkout System" in which a customer scans items and places them in a cart, and then a cashier or security guard spot checks items to see that they have been scanned by the customer and accepts payment at a POS terminal. Swartz, Title and Abstract; col. 8, lines 37-45. Swartz "methodology determines how many items to check for a given shopper as well as what particular items to check for that shopper." Abstract; see also, col. 2, lines 9-17. The methodology of Swartz is ultimately implemented by the cashier or security guard and as such

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cannot meet the terms of the present claims which address systems and system implemented methods. Configuring a system is not met by checking items by hand by a human. Walter, which addressing a highly advantageous "Self-Service Checkout Apparatus" assigned to the assignee of the present application does not cure the apparent defects of Swartz with respect to the present claims. Further, while Walter addresses accepting payment, it does not address accepting payment "in accordance with the security level" determined based on the risk level as claimed by claim 1.

With respect to claim 1, Swartz completely lacks the step of "configuring the self-service checkout system . . ." as claimed. Rather than "configuring the self-service checkout system", Swartz has a human being apply a different level of security by checking a different number of products. Claim 1 is not obvious therefrom.

Regarding claim 2, while the relied upon text of Swartz at col. 4, lines 27-42 addresses scanning a "loyalty card", it does so in the context of dispensing a scanning terminal 100 from the dispenser 2 to a shopper. As a result, this portion of Swartz does not meet the remainder of the claim in which the obtained identification information is used in "determining a risk level associated with the identification information of the customer." At Swartz col. 4, lines 43-46, Swartz indicates that it is determined if the customer is "allowed to access a terminal 100 (i.e., the shopper is a member of the self-service system)".

Claim 5 addresses "obtaining current transaction data of the customer" and assigning risk in part based thereon. The Official Action relies on Swartz col. 6, lines 45-54 and col. 7, lines 35-55. Neither portion of Swartz meets the claim. Col. 6, lines 45-54 simply state after "determining that the shopper has completed selecting and scanning items for purchase, the host

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computer" determines which items to check. The bases for determining what items to check do not appear to include any analysis of the items in the current transaction.

With respect to claim 6, again the cited portions of Swartz do not meet the language of this claim.

With respect to claim 7, Swartz does not appear to establish categories of risk levels apparently analyzing situations on a case by case basis. The remaining claims are similarly not met by Swartz.

With respect to claim 15, the customer-operated self-service checkout system includes a scale and the configuring includes "configuring the self-service computer to perform weight checks" as addressed at page 3, lines 9-11, for example. The cited portions of Swartz do not meet this claim language.

**B. Rejection Under 35 U.S.C. § 103(a) over Swartz in view of Walter and Zhang**

This rejection is not supported by the relied upon art. 35 U.S.C. § 103 which governs obviousness indicates that "differences between the subject matter sought to be patented and the prior art" are to be assessed based upon "the subject matter as a whole". Analyzing the entirety of each claim, the rejections under 35 U.S.C. § 103 are not supported by the relied upon art as addressed further below. Only after an analysis of the individual references has been made can it then be considered whether it is appropriate to combine teachings. However, as addressed further below, an objective analysis considers failure of others, the lack of recognition of the problem, and must avoid the improper hindsight reconstruction of the present invention. Such an analysis can appropriately consider whether any modifications are actually suggested by the

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references rather than assuming they are obvious. The 35 U.S.C. § 103 rejections made here pick and choose elements from either two or three separate references.

### Claim 3

Claim 3 was rejected based on Swartz, Walter and Zhang. Zhang does not cure the failings of Swartz and further addressed at length above.

#### C. The Examiner's Findings of Obviousness are Also Contrary to Law of the Federal Circuit

As shown above, the invention claimed is not taught and not suggested by the relied upon prior art. The references cited by the Examiner, if anything, teach away from the present invention. It is only in hindsight, after seeing the claimed invention, that the Examiner could combine the references as the Examiner has done. This approach is improper under the law of the Federal Circuit, which has stated that "[w]hen prior art references require selective combination by the Court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself." Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 U.S.P.Q. 2d 1434, 1438 (Fed. Cir. 1988), cert. den., 109 S. Ct. 75, 102 L.Ed. 2d 51 (1988); quoting Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1132, 227 U.S.P.Q. 543, 535 (Fed. Cir. 1985). Furthermore, "[i]t is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention." Uniroyal, 837 F.2d at 1051, 5 U.S.P.Q. 2d at 1438.

In addition, the Examiner does not appear to have considered "where the references diverge and teach away from the claimed invention", Akzo N.V. v. International Trade Commission, 808 F.2d 1471, 1481, 1 U.S.P.Q. 2d 1241, 1246 (Fed. Cir. 1986), cert. den., 107 S.

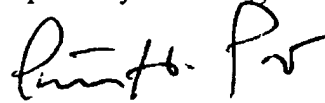
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Ct. 2490, 482 U.S. 909, 107 S.Ct. 2490 (1987); and W.L. Gore Associates, Inc., 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983); nor has the Examiner read the claims as a whole, as required by statute. 35 U.S.C. §103. See also, Smithkline Diagnostics Inc. v. Helena Laboratories Corp., 859 F.2d 878, 885, 8 U.S.P.Q. 2d 1468, 1475 (Fed. Cir. 1988); and Interconnect Planning Corp., 774 F.2d at 1143, 227 U.S.P.Q. at 551.

The Examiner's rejection suggests that the Examiner did not consider and appreciate the claims as a whole. The claims disclose a unique combination with many features and advantages not shown in the art. It appears that the Examiner has oversimplified the claims and then searched the prior art for the constituent parts. Even with the claims as a guide, however, the Examiner did not recreate the claimed invention.

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Respectfully submitted,



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